

REMARKS

After careful consideration of the outstanding Office Action, this application is submitted for reconsideration on the merits absent amendment and a request for prompt allowance.

The singular issue of record is presented at page 2, paragraph 4 of the outstanding Office Action at which the Examiner rejected claims 1 through 4 and 8 through 10 "under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art in view of Kato, et al. (herein referred to as Kato), USPN 5,832,215." Before considering the latter rejection and the Examiner's rationale therefor, reference is made to the MANUAL OF PATENT EXAMINING PROCEDURE, Section 2141 thereof captioned "35 U.S.C. 103; the Graham Factual Inquiries." At page 2100-115, the following is quoted from the Supreme Court decision of Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966):

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

The undersigned appreciates the Examiner's analysis under the Graham decision with respect to both determining the scope and content of the prior art and ascertaining the differences therebetween, as set forth at page 2, paragraph 5 and continuing through line 2 of page 4. The Examiner specifically determined "Applicant's admitted prior art does not explicitly teach"... the subject matter of Applicant's invention, as the Examiner states in the Office Action beginning at page 3, line 12 of the Office Action. The

latter subject matter is, of course, also claimed and, therefore, the differences between the prior art and the claims in issue are also most "explicitly" stated.

The problem the undersigned finds in the Section 103(a) rejection is the manner in which the Examiner has resolved the issue of obviousness/unobviousness by first stating a conclusion ("It would have been obvious," etc.) followed by alleging that the motivation for utilizing the secondary patent to Kato is "taught by Applicant's admitted prior art thus saving time, preventing the need to make register modifications, and improving the efficiency of the system." Applicant's admitted prior art clearly admits **advantages** obtained once the **disadvantages** of admitted prior art communication systems have been **unobviously** discovered and **unobviously** resolved by the present invention. The Examiner has basically utilized hindsight in analyzing Applicant's disclosed and claimed invention, found the patent to Kato and thereafter concluded that by following Applicant's teaching and utilizing the patent to Kato, the resulting communication system may achieve "saving time, preventing the need to make register modification, and improving the efficiency of the system.") The factual situation is that the admitted prior art has problems recognized by Applicant, which are described beginning at page 1 of the specification under the caption "BACKGROUND ART" and proceeding to the last paragraph of page 3. At this point, it is Applicant who recognizes the disadvantages of ^{loss of} ~~the~~ _{water} the prior art, not anything admitted thereby explicitly, inferentially or otherwise. It is Applicant who recognized the disadvantages in conventional communication systems (100) and went through considerable detail describing such disadvantages through page 4 and the top of page 5 of the

present specification. Neither the patent to Kato nor a person skilled in the art considering the same would be motivated toward unobviously inventing the subject matter which the Examiner then concludes, absent correct application of the Graham factors, that it would have allegedly been "obvious to one or [sic] ordinary skill in the art at the time the invention was made to incorporate the broadcasting method, a common bus, and the reception control unit (a detection means) taught by Kato within the system taught by Applicant's admitted prior art." The latter is only "taught" by Applicant in the present application, not by Applicant's admitted prior art.

Somewhat more recently than the Graham decision the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences in Ex parte Granneman, 68 USPQ2d 1219, 1221 deals with the issue of duplication (or reduction) of parts, whether the same may or may not be obvious, and the general reliance on per se rules of obviousness. The Board stated:

[1] For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The Examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84.

The Examiner has basically proceeded in the same manner as did the Examiner in the Ex parte Granneman decision by recognizing that Applicant's admitted prior art includes multiple communication devices and the disadvantages thereof recognized only by Applicant, yet fails to find in the

prior art any suggestion of the desirable modification. Just as importantly, the system disclosed in the Kato patent is actually not even operative in conjunction with the present invention because it utilizes double buffers, namely, a transmission buffer for temporarily storing data to be transferred from one processor to other processors and for sequentially transmitting all data to a common bus with each of the other processors having a reception buffer for temporarily storing data which is received. Recognizing that Applicant's invention utilizes but a single memory buffer, and until Applicant's invention, none recognized the advantages thereof, the admitted prior art would most definitely not motivate or suggest to one skilled in the art to utilize the Kato disclosure.

The undersigned also brings to the attention of the Examiner that the Graham factors require an analysis of the subject matter *as a whole*, not bits and pieces thereof. Not only does Kato's communication system require double buffers, as aforesaid, but in Kato's communication system data is received from the common bus in a receptor buffer (column 2, lines 40-44) while Applicant's invention calls for detecting control information and forwarding it directly to the communication protocol modules without the use of any form of reception buffers.

Kato's communication system can also process control information after it is temporarily stored in reception buffers, but in keeping with one aspect/embodiment of Applicant's invention, specialization communication protocol modules are utilized to eliminate or reduce processing resources that are required by the Kato system.

Finally, in Kato's communication system the buffers are uni-directional, i.e., data which is to be transferred is pre-stored in the transmission buffers

(column 7, lines 39-40), whereas in accordance with Applicant's invention a bi-directional memory buffer is used to both send control information and also receive status information which, obviously, is more flexible and efficient than the pure transmission buffer of the Kato communication system.

Considering all of the subject matter of the Kato patent *as a whole*, nothing therein would suggest or motivate a person skilled in the art to utilize the same in the manner set forth by the Examiner in the outstanding Office Action at page 2, paragraph 4. Accordingly, the withdrawal of the latter rejection and the formal allowance of each of the claims of record is believed proper and would be most appreciated.

The early allowance of this application is again respectfully requested.

Respectfully submitted,
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